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### **REMARKS**

This amendment responds to the Office Action dated September 29, 2003. Claims 1-2 and 11-23 have been amended to correct an error in claim dependency and other informalities noted upon reviewing these claims. Claim 1 has been further amended to clarify the claim as per the Examiner's comments below. Claims 1-23 remain pending in this application. The specification has been amended to be consistent with drawing changes requested by the Examiner.

### **DRAWINGS SATISFY 37 C.F.R § 1.83(A)**

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) as failing to show every feature of the invention specified in the claims. Specifically, the Examiner contends that a plurality of remote display interfaces arranged in a peer-to-peer network of claim 3, a Personal Video Recorder of claim 9 and a communications module adapter to transmit said graphical data received by said input module of claim 11 must be shown or the features cancelled from the claims.

While the Applicant believes the existing drawings support these features, however, the Applicant has amended the drawings to more explicitly show them. For example, with regard to claim 3, FIG 1 has been amended to depict the peer-to-peer network as set forth in original claim 3. The specification at paragraph 0026 has been amended to refer to FIG 1 as appropriate and to be consistent with FIG 1 and original claim 3. No new matter has been added as the amendments to FIG 1 and paragraph 0026 are described in the original paragraph 0026 and original claim 3.

With regard to claim 9, FIG 1 has been amended to indicate the Personal Video Recorder, as described in original claim 9. The specification at paragraph 0021 has been amended to refer to FIG 1 as appropriate and to be consistent with FIG 1 and original claim 9. No new matter has been added as the amendments to FIG 1 and paragraph 0021 are described in the original paragraph 0021 and original claim 9.

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With regard to claim 11, FIG 1 has been amended to depict the communications module as described in original claim 11. Paragraph 0018 has been amended to be consistent with FIG 1 as amended and to include the material from claim 11 and the summary of the invention section. No new matter has been added as the amendments to FIG 1 and paragraph 0018 are described in the summary of the invention section at page 2, paragraph 0007 and original claim 11.

The Applicant has submitted a revised drawing sheet for FIGs 1-2 detailing the above-mentioned changes to FIG 1, a copy of which is included herein for the Examiner's approval. Reconsideration and withdrawal of the objection to the drawings is therefore respectfully requested.

#### **CLAIMS 12-22 ARE NOT OBJECTIONABLE**

The Examiner objected to claims 12-22 as being dependent upon the wrong claim. The Applicant has corrected this informality. Reconsideration and withdrawal of the objection to claims 12-22 is therefore respectfully requested.

#### **CLAIMS 11-22 SATISFY 35 U.S.C. § 112, ¶ 1**

The Examiner rejected claims 11-22 as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains or with which it is most nearly connected to make and/or use the invention. Specifically, the Examiner contends that the claimed feature "a communication module adapted to transmit said graphical data received by said input module" and "a remote server operatively connected to the communication module for receiving the graphical data" are not supported by the specification to enable one of ordinary skill in the art to make and/or use the invention. The Applicant respectfully disagrees with these contentions.

With regard to the first claimed feature "a communication module adapted to transmit said graphical data received by said input module", the Applicant notes that FIG 1 depicts an input device 101 coupled to a point-of-presence server 102. The input device 101 is taught at

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page 4, paragraph 0016 as having a touch screen interface that permits the input of data via a stylus. The same paragraph states that the

"input device may be a wireless web appliance that combines a wireless transceiver, computer processor, memory, display and input device with a web-browser application that allows a combination of graphics and text (and in some cases, audio and motion video) to be displayed using data received over a wireless link."

At page 5, paragraph 0018, the input device is taught to include a "wireless transceiver to send and receive wireless signals to and from server 102 over a bidirectional wireless link." Further, at page 5, paragraph 0019, the specification teaches:

In operation, a user desiring to overlay a graphic onto a video stream broadcast on a local or remote display device such as a television, for example, describes the graphic on the touch screen interface of the input device 101. . . . In response to a user instruction, the graphic is then transmitted to the server 102. . . . Once the transmitted graphical data is received and processed by server 102, the graphical data is transmitted by server 102 to the display device interface 103 over any of the aforementioned transmission means."

Thus, the input device 101 can include an input module (e.g., a touchscreen, stylus and memory) to receive and store graphical data input by a user. Furthermore, the input device 101 can also include a communication module (e.g., a wireless transceiver) adapted to transmit the graphical data received by said input module. The apparatus shown in FIG 1 then also includes a remote server (e.g., point-of-presence server 102) operatively connected to the communications module for receiving the graphical data. Further, as taught at page 5, paragraph 0018, the input device 101 may communicate with server 102 over a bi-directional wired link such as a coaxial cable.

In general, the term communications module can cover the transmission function, the reception function, both functions, or multiple ones of each for communicating between the server 102 and the input module (part of input device 101), depending on the specific embodiment. Moreover, modem 134 in FIG 3 may be part of the communications link between input device 101 and server 102, depending on the configuration of the specific embodiment.

For example, in one possible implementation a cable modem (such as modem 134) coupled to a wireless network to which input device 101 is coupled could receive a

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communication of a graphic from the input device 101 that is addressed to remote server 102, in which case the cable modem would forward the communication of the graphic to remote server 102. If the graphic were then intended to be overlain on video output to a television to which the cable modem is coupled, the graphic would then be communicated back to the cable modem 134 and forwarded to server interface 62.

Alternatively, for example, a first cable modem (such as modem 134) coupled to a wireless network to which input device 101 is coupled could receive a communication of a graphic from the input device 101 that is addressed to remote server 102, in which case the first cable modem would forward the communication of the graphic to remote server 102. If the graphic were then intended to be overlain on video output to a television to which a second cable modem is coupled, the graphic would then be communicated to the second cable modem (different than the first cable modem) via, for example, a cable plant, and forwarded to server interface 62, for subsequent processing.

Still, communication module could be the portion only of the input device that enables the input device to transmit the graphic information. Or, communication module could be any portion of the communications link between the input device and the server.

Nevertheless, the specification teaches a communications module that transmits graphic information received by an input module to a remote server so that one of ordinary skill in the art would be able to make and use the invention. Reconsideration and withdrawal of the objection to claims 12-22 is therefore respectfully requested.

#### **CLAIMS 1-10 SATISFY 35 U.S.C. § 112, ¶ 2**

The Examiner rejected claims 1-10 as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant has amended the claims in accordance with the Examiner's remarks. As such, the claims at issue now particularly point out and distinctly claim the subject matter which Applicant regards as the invention; hence, reconsideration and withdrawal of the objection to claims 1-10 is therefore respectfully requested.

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**CLAIMS 1-2 AND 4-23 ARE PATENTABLE OVER  
SULLIVAN ET AL. AND JAMBHEKAR ET AL.**

The Examiner rejected claims 1-2 and 4-23 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,593,973 to Sullivan et al. [hereinafter "Sullivan et al."] in view of U.S. Patent No. 5,848,356 to Jambhekar et al. [hereinafter "Jambhekar et al."]. Essentially, the Examiner contends that Sullivan et al. discloses all of the elements of the claims at issue, except for an input device adapted to receive, to store an instruction corresponding to a graphic data and to transmit graphic data to a remote server." The Examiner then cites Jambhekar et al. as providing this missing teaching. Finally, the Examiner contends that it would have been obvious to one of ordinary skill in the art "to provide an input device in the device of [Sullivan et al.], in view of the teaching in the [sic] [Jambhekar et al.] because this would provide a user an easier way to compose and to transmit his message to others as taught by [Jambhekar et al.]." The Applicant respectfully disagrees with the Examiner's characterization of these references vis-à-vis the claims at issue.

A *prima facie* case of obviousness based on these two references cannot stand because even assuming *arguendo* that these references may be combined (in fact, they cannot be properly combined as shown below), any combination fails to result in the claimed inventions. For example, claim 1 includes the recitation "selectively transmitting said data corresponding to said at least one instruction from said remote server to said at least one display interface wherein said at least one display interface overlays said graphic on the received video broadcast displayed on said display device." Similar recitations appear in the other independent claims.

First, Sullivan et al. fails to disclose overlaying a graphic upon a video image being displayed on a display device. In contrast, Sullivan et al. discloses a method for *replacing* a video signal with an alternate source during a transition from one video source to another video source. Sullivan et al. specifically teaches that such "overlaying" (which is in fact not overlaying but replacing) must occur during the transition period to take advantage of an otherwise blank screen caused by such a transition period. While Sullivan et al. states

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"overlying" the video, in fact, Sullivan et al. merely replaces the video with another source during the transition period. Thus, Sullivan et al. does not overlay video from a broadcast source with a graphic generated from a user input device, as set forth in the claims at issue.

As mentioned by the Examiner, Jambhekar et al. fails to teach overlaying a graphic onto a video from a broadcast source. The Applicant concurs. Jambhekar et al. relates to mobile telephones and as such does not disclose a system in which a graphic can be integrated into a video being displayed on a television. In fact, Jambhekar et al. relates to the use of functional icons to represent information, but not to generate a graphic that is transmitted to a server for overlaying onto a video being displayed.

Therefore, the combination of these references (*i.e.*, Sullivan et al. and Jambhekar et al.) also fails to result in the invention set forth in the claims at issue. As these recitations are not included in Sullivan et al. or Jambhekar et al. (even assuming *arguendo* these references can be combined in the manner suggested by the Examiner), claims 1, 11 and 23, and those that depend therefrom, are therefore patentable over Sullivan et al. and Jambhekar et al., either taken alone or in the combination suggested by the Examiner.

Moreover, even assuming *arguendo* that Sullivan et al. discloses this missing teaching, Sullivan et al. cannot be combined with Jambhekar et al. to arrive at the claimed invention because it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In sum, Sullivan et al. teaches away overlaying graphics on a video because Sullivan et al. states one must insert an alternate video source (as opposed to a graphic) during a transition period – not just during any part of the video source. Thus, Sullivan et al. teaches that any replacement or "overlying" must occur during a transition period. This teaches away from overlaying a graphic on the video to create a combined video and graphic because during a transition period no video is being displayed. As mentioned above, the present invention enables the overlaying of a graphic

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generated by a handheld user input device onto a video source so that the combined video (*i.e.*, not simply a blank screen) and graphic is displayed. As Sullivan teaches away from combining a graphic with a video during a non-transition period any combination that would purport to overlay video and graphics that would include Sullivan et al. is not proper. Reconsideration and withdrawal of the rejection of claims 1-2 and 4-23 is therefore respectfully requested.

### CLAIM 3 IS PATENTABLE OVER

#### SULLIVAN ET AL., JAMBHEKAR ET AL. AND DAILEY

The Examiner rejected claims 3 under 35 U.S.C. §103(a) as being unpatentable over Sullivan et al. in view of Jambhekar et al. and further in view of U.S. Patent No. 5,642,350 to Dailey [hereinafter "Dailey"]. Essentially, the Examiner contends that the above combination of Sullivan et al. and Jambhekar et al. discloses all of the elements of the claims at issue, except "teaching a plurality of remote display interfaces arranged in a peer-to-peer network." The Examiner then cites Dailey as providing this missing teaching. Finally, the Examiner contends that it would have been obvious to one of ordinary skill in the art "to provide a plurality of remote display interfaces arranged in a peer-to-peer network in the device of Sullivan because this would permit every device on the network to initiate as well as receive messages from other devices on the network, as taught by Dailey." The Applicant respectfully disagrees with the Examiner's characterization of these references vis-à-vis the claim at issue.

Dailey fails to teach a method by which a graphic can be overlain on a video image. As these recitations are not included in Sullivan et al., Jambhekar et al. or Dailey (even assuming *arguendo* these references can be combined in the manner suggested by the Examiner), claim 3 is therefore patentable over Sullivan et al., Jambhekar et al. and Dailey, either taken alone or in any combination. Reconsideration and withdrawal of the rejection of claim 3 is therefore respectfully requested.

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### CONCLUSION

The Applicants respectfully submit this application is in condition for allowance and request issuance of a Notice of Allowability.

In the event the prosecution of this application can be efficiently advanced by a phone discussion, it is requested that the undersigned attorney be called at (703) 435-9390.

### FEEs

If additional amounts are due following the amendments made to the claims above, or for any other reason, it is respectfully requested that the PTO charge any deficiency or credit any overpayment to the deposit account of Mayer Fortkort & Williams PC, Deposit Account, #50-1047.

Respectfully submitted,

By   
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